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Supreme Court, U.S.
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No. _____

In the
Supreme Court of the United States

STEPPENWOLF PRODUCTIONS, INC., and
STEPPENWOLF, INC.,

Petitioners,

v.

NICHOLAS KASSBAUM, aka NICK ST. NICHOLAS,

Respondent.

On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Ninth Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

With respect to a supplemental contract claim (i.e., where the District Court exercised supplemental jurisdiction) that is governed by California contract law, did the Ninth Circuit err in creating a rule of contract law contrary to existing California and Ninth Circuit decisions?

CORPORATE DISCLOSURE STATEMENT

Petitioners herein state that there is no parent, or publicly held company owning stock, of either Petitioner herein. Supreme Court Rules 14(b), 29.6.

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PETITION FOR WRIT OF CERTIORARI

Petitioners Steppenwolf Productions, Inc. and Steppenwolf, Inc. respectfully request that this Court issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Ninth Circuit entered in this proceeding on December 29, 2000.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Ninth Circuit that gives rise to this petition is reproduced in Appendix A hereto at pages 1a – 17a. The decision of the Ninth Circuit denying the petition for rehearing and request for rehearing en banc is reproduced in Appendix B hereto at pages 1b – 2b. The opinion, permanent injunction and final judgment of the United States District Court for the Central District of California are reproduced in Appendix C hereto at pages 1c - 20c.

JURISDICTION

The opinion of the United States Court of Appeals for the Ninth Circuit was issued on December 29, 2000. App.A. A timely-filed petition for rehearing and request for rehearing en banc was denied by the Ninth Circuit on February 7, 2001. App.B. Pursuant to Supreme Court Rule 13.1, this petition has been filed within 90 days of the denial of rehearing. This Court has jurisdiction under 28 U.S.C. §1254(1).

STATEMENT OF THE CASE

On November 25, 1997, Respondent Nicholas Kassbaum, aka Nick St. Nicholas, filed his Complaint for Declaratory Relief against Appellees Steppenwolf Productions, Inc. ("SPI") and Steppenwolf, Inc. ("SI")* in the U.S. District Court for the Central District of California. ER 54-161.** The Respondent sought the right to use the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf" and "Original Founding Member of Steppenwolf." ER 65(¶ 46).

On January 6, 1998, SPI answered the Complaint by denying the principal allegations and by asserting eight affirmative defenses. ER 162-171. On February 27, 1998, SI answered the Complaint. ER 214-223.

Also on January 6, 1998, SPI filed its Counter-Claims against the Respondent, alleging claims for federal unfair competition, federal trademark infringement, dilution of the trademark, common law trademark and trade name infringement, common law unfair competition and breach of contract (Sixth Counter-Claim). ER 172-202. On January 29, 1999, the Appellant filed his

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*John Kay was also named as a defendant, but the District Court granted his motion to dismiss on April 3, 1998. App.C, p. 5c.

** Abbreviations herein: "ER" (followed by a page number) refers to the "Appellant's [Respondent Kassbaum's] Excerpts of Record; " "ASER" (followed by a page number) refers to the "Appellees' [SPI's and SI's] Supplemental Excerpts of Record".

"Reply to Counter-Claims", in which he denied the principal allegations of the Counter-Claims and asserted eight affirmative defenses. ER 203-213.

On November 25, 1998, SPI and SI filed a motion seeking summary judgment against the Respondent with respect to his Complaint, seeking summary adjudication in favor of SPI and against the Respondent with respect to the liability of the Respondent under SPI's Sixth Counter-Claim (for breach of contract) and seeking the issuance of a permanent injunction against the Appellant enjoining his use of the name "Steppenwolf". ER 224-344, 726-751. On January 6, 1999, the District Court granted the motion (i) for summary judgment in favor of SPI and SI on the Complaint, (ii) for summary adjudication in favor of SPI with respect to the liability of the Respondent under the Sixth Counter-Claim for breach of contract and (iii) for a permanent injunction precluding the Respondent "from using the designations 'Formerly of Steppenwolf', 'Original Member of Steppenwolf' and 'Original Founding Member of Steppenwolf', in promotional materials". App.C, pp. 1c-14c. Relying on California and Ninth Circuit cases, the District Court held that:

> "Here, the terms of the 1980 Contract are clear and unambiguous. [Respondent] Kassbaum, a signatory to the 1980 Contract, agreed that 'SPI and SI own all right, title and interest in the names "Steppenwolf"' and that SPI and SI 'have the sole and exclusive right to use the name "Steppenwolf" in connection with . . . records, . . .

performances of a musical group, and all other uses of the name 'Steppenwolf' in the entertainment industry.' Plaintiff further agreed to relinquish all rights in the name "'Steppenwolf" or any other word or phrase incorporat[ing] the name "Steppenwolf" for any purpose whatsoever.'... (emphasis added). In the 1980 Contract, Kassbaum also agreed to be enjoined from using the name 'Steppenwolf' or any name which includes or incorporates the name 'Steppenwolf' if he breached that contract....

"The 1980 Contract is thus unambiguous on its face. As noted, however, California law allows a party to challenge a contract that is unambiguous on its face, see Brobeck, 602 F.2d at 873, and accordingly, Kassbaum presents extrinsic evidence to this Court in order to show that the contract was susceptible of a different meaning.

"The extrinsic evidence advanced by Kassbaum consists almost exclusively of Kassbaum's own understanding and intention that the 1980 Contract prohibited him only from recording records as 'Steppenwolf' or using 'Steppenwolf' in the name of a band.... However, Kassbaum's subjective belief is irrelevant in determining the meaning of the 1980 Contract. See

Brobeck, 602 F.2d at 873. Under the modern theory of contracts, courts look to objective, not subjective, criteria in ascertaining the intent of the parties. See id; see also Meyer v. Benko, 55 Cal.App.3d 937 (1976). Moreover, the undisclosed independent intention of Plaintiff is neither relevant nor binding on the other parties to the 1980 Contract. See Ede v. Ede, 208 Cal.App.2d 718, 721 (1962). Plaintiff offers no evidence that he ever communicated an intention to limit his obligations under the 1980 Contract. The unexpressed thoughts of a party to a contract are simply irrelevant. See Meyers v. Guaranteed Sav. & Loan Assn., 79 Cal.App.3d 307, 311 (1978). 'Testimony of intention which is contrary to a contract's express terms...does not give meaning to the contract; rather it seeks to substitute a different meaning...such evidence must be excluded.' See Gerdlund v. Electronic Dispensers Int'l, 190 Cal.App. 3d 263, 273 (1987).

"Plaintiff also submits that the fact that Defendants themselves refer to Plaintiff's past membership, history and performance with the band Steppenwolf, indicates the parties' intention to allow Plaintiff to refer to his past affiliation with Steppenwolf. However, again, the clear language of the 1980 Contract is the best evidence

of SPI's intent. The 1980 Contract clearly provides that SPI and SI 'have the sole and exclusive right to use the name "Steppenwolf" in connection with ...records, ...performances of a musical group, and all other uses of the name "Steppenwolf" in the entertainment industry.'... (emphasis added). The right to refer to the name 'Steppenwolf' is explicitly reserved to SPI and SI. The use of the words 'sole' and 'exclusive' evidences a clear and unambiguous intention by the parties to the 1980 Contract to limit that right to SPI and SI's use.

"Thus, the Court finds that the extrinsic evidence offered by Plaintiff does not make the contract reasonably susceptible to a different interpretation. The terms of the 1980 Contract remain unambiguous, and thus disposition of the case by summary judgment is appropriate.... In light of the express terms of the 1980 Contract, Plaintiff's continued use of the designations 'Formerly of Steppenwolf,' 'Original Member of Steppenwolf,' and 'Original Founding Member of Steppenwolf' to promote his band, 'World Class Rockers,' is in violation of the terms of the 1980 Contract.[] As such, Defendants are entitled to enjoin Plaintiff from using said designations in his promotional materials...." (Citations omitted. Emphasis in original. App.C,

pp.10c-13c.)*

On March 16, 1999, the District Court issued a Permanent Injunction (App.C, pp. 15c-17c) enjoining the Respondent from:

> "using or causing, directly or indirectly, orally or in writing, the designations 'Formerly of Steppenwolf,' 'Original Member of Steppenwolf' and 'Original Founding Member of Steppenwolf' and all other designations that include the word 'Steppenwolf' to advertise or promote or market [the Respondent]...."**

On May 19, 1999, in response to the motion of SPI and SI, the District Court: (i) dismissed all of SPI's Counter-Claims, other than the Sixth Counter-Claim (for breach of contract) (ER 47-48); and (ii) entered Final Judgment in this case dismissing the Respondent's Complaint, adjudging the Respondent liable with respect to SPI's Sixth Counter-Claim and confirming the Permanent Injunction entered against the Respondent on March 18, 1999. App.C, pp. 18c-20c.

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* On May 15, 1999, the District Court denied the Respondent's motion for reconsideration. ER 35-42.

** The injunction specifically does not restrain:

"(a) References to 'Steppenwolf' in an autobigraphy, biography or memoir of Kassbaum; and

"(b) References to 'Steppenwolf' in liner notes, inserts or covers of records that were manufactured on or before the date of this injunction." App.C, p. 16c.)

On March 26, 1999, the Respondent filed a Notice of Appeal seeking review by the Ninth Circuit of the District Court's Permanent Injunction entered on March 18, 1999, Order of March 15, 1999 denying the Respondent's motion for reconsideration, and Summary Judgment dated January 8, 1999. ER 1, 2. On June 21, 1999, the Respondent amended his prior Notice of Appeal to add the District Court's Order of May 20, 1999 dismissing certain SPI Counter-Claims and the Final Judgment of May 20, 1999. ER 6-18.

On December 29, 2000, the Ninth Circuit reversed and remanded the District Court's "order (1) granting summary judgment to SPI and SI on the complaint for declaratory judgment and on the contract counterclaim; (2) dismissing Kassbaum's complaint for declaratory judgment; and (3) granting SPI and SI's request for a permanent injunction." The Ninth Circuit remanded the case to the District Court "with instructions to reinstate Kassbaum's complaint for declaratory relief and for further proceedings consistent with this opinion." App.A, p. 17a.

On January 12, 2001, the Petitioners filed a petition for rehearing and a request for rehearing en banc with the Ninth Circuit, which petition was denied by the Ninth Circuit on February 7, 2001. App.B, pp. 1b-2b.

REASONS FOR GRANTING THE WRIT

1. The standard for certiorari.

Certiorari has been granted where there is a conflict between a Court of Appeals decision and state court decisions. See Dept. of Revenue of Montana v. Kurth Ranch, 511 U.S. 767, 776 (1994) (conflict between Ninth Circuit and state Supreme Court decision in another case); Madsen v. Women's Health Center, Inc., 512 U.S. 753, 762 (1994). Federal courts are bound by the decisions of the highest court of the state and by the decisions of the state's intermediate appellate courts. A conflict with or a refusal to follow such state court decisions is a basis for review of a decision of a Court of Appeals. Six Companies v. Joint Highway District, 311 U.S. 180 (1940); West v. American T&T Co., 311 U.S. 223, 235 (1940); Stoner v. New York Life Ins. Co., 311 U.S. 464 (1940). In Six Companies, the Court of Appeals expressly failed to follow applicable California state court precedent on the issue of the applicability of a liquidated damages provision in a contract. This Court "granted certiorari limited to the question of whether there was error in that ruling." 311 U.S. at 185.

Certiorari has also been granted where there is an intracircuit conflict. Dickinson v. Petroleum Conversion Corp., 338 U.S. 507, 508 (1950); John Hancock Ins. Co. v. Bartels, 308 U.S. 180, 181 (1939); see Scarborough v. United States, 431 U.S. 563, 567, n.4 (1977) ("The Ninth Circuit apparently has an intra-Circuit conflict.").

Moreover, where the error by the Court of Appeals is clear, there is additional reason for granting certiorari. See Washington v. United States, 357 U.S. 348 (1958) (certiorari was granted and, in a brief per curiam opinion, judgment was "reversed because of the insufficiency of the evidence"); Thompson v. City of Louisville, 362 U.S. 199, 203, 206 (1960) (certiorari was granted "to review the police court's judgments," which were reversed by this Court because there was "no evidence whatever...to support these convictions"); Chicago & N.W. Tr. Co. v Kalo Brick & Tile Co., 450 U.S. 311 (1981) (certiorari was granted where there was an obviously incorrect application of the federal preemption doctrine); Arizona v. Maricopa County Medical Society, 457 U.S. 332,336 (1982) (certiorari was granted "because the undisputed facts disclose a violation of the statute [Sherman Act]...."and this Court then reversed the Ninth Circuit).

Under Supreme Court Rule 10, this Court, in exercising its discretion regarding a petition for a writ of certiorari, considers whether the Court of Appeals "has so far departed from the accepted and usual course of judicial proceedings...as to call for an exercise of this Court's supervisory power...."

Certiorari is appropriate here, as more fully described and argued below, because the Ninth Circuit decision here (App.A) conflicts with and fails to follow applicable California state court decisions, because the Ninth Circuit decision here also conflicts with and fails to follow applicable Ninth Circuit precedent and because the error of the Ninth Circuit

in this case is clear and calls for the exercise of this Court's supervisory power.

In West v. American T & T Co., supra, 311 U.S. at 235, this Court granted certiorari "upon a petition which set up that the Court of Appeals had erroneously failed to apply the Ohio law...[as to the accrual of a certain cause of action] and that the court below had erroneously applied the Ohio rule of limitations and of laches, all questions of public importance concerning the interrelation of state and federal courts." Similarly, here there is a question of "public importance" regarding California contract law, which involves "the interrelation of state and federal courts."

2. The Ninth Circuit Opinion.

In its analysis of the contract issue (App.A, pp. 8a-11a) the Ninth Circuit pointed out that the Respondent had conceded that his 1980 Contract precluded him from performing, sponsoring, or endorsing a band entitled "Steppenwolf." The question, as identified by the Ninth Circuit, was whether the contracting parties intended the broad language in the 1980 Contract to bar the Respondent from mentioning "Steppenwolf" in answering a question about his past, distributing a resume, or describing his past musical affiliations in promotional materials connected with the World Classic Rockers.* The Ninth Circuit acknowledged

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*The Ninth Circuit quipped that the broad language in the 1980 Contract, if taken "out of context," would preclude the Respondent from writing "Steppenwolf" on the sidewalk in chalk. But the Court acknowledged that SPI and SI did not

that SPI and SI merely sought to prohibit the Respondent from using the name "Steppenwolf" in the entertainment industry. (And the injunction issued by the District Court was similarly narrow. App.C, p. 16c.)

The Ninth Circuit noted that the District Court had "exercised...supplemental jurisdiction regarding the contract claim," and the Ninth Circuit held that California law is applicable to the contract claim. App.A, pp. 8a-9a, fn. 4. Nevertheless, the Ninth Circuit proceeded to ignore the relevant California and its own precedents. See pp. 19-26 below. Instead, the Ninth Circuit in essence negated the 1980 Contract to the extent that it prohibited the Respondent from any use by the Respondent of "Steppenwolf" in the entertainment industry.

The Ninth Circuit held that when it encounters broad language such as "for any purposes whatsoever," it must extend the meaning of such language to cover only those things which it appears the parties intended to contract. The Ninth Circuit stated that the 1980 Contract was formed when there was a continuing dispute between the parties about ownership and control over the trade name Steppenwolf. According to the Ninth Circuit, at the time the 1980 Contract was entered, the Respondent owned the trade name Steppenwolf and that the 1980 Contract effected the transfer of the trade name Steppenwolf from the Respondent to SPI and SI. (Contrary to the Ninth Circuit's view (App.A, pp. 10a-11a), the ownership of "Steppenwolf" was never in issue; the 1977 and 1979 agreements

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advocate such a restriction. App. A, p. 9a.

involved the owners of "Steppenwolf", SPI and SI, licensing its use to others (ER 493-494, 501-505), and the 1980 Contract confirmed that SPI and SI owned "Steppenwolf.")

The Ninth Circuit held that under these circumstances, the 1980 Contract's broad language refers to the use of the trade name "Steppenwolf", and "not to the simple use of the name to provide accurate historical information that would not lead reasonable people to think Kassbaum's new band was Steppenwolf." Based on the foregoing, the Ninth Circuit held that the 1980 Contract does not bar the Respondent "from referring to his former membership in Steppenwolf in the entertainment industry or otherwise." App.A, p.11a. The Ninth Circuit reversed the issuance of the permanent injunction against the Respondent, the summary judgment against Respondent on the contract counterclaim and the dismissal of the Respondent's Complaint. App.A, p.17a.

The Ninth Circuit's Opinion, if allowed to stand, will serve to impair the integrity of contracts and unreasonably limit the ability of parties to contract.

3. The Ninth Circuit Opinion conflicts with and is contrary to state case law and Ninth Circuit precedents.

a. The 1980 Contract.

The band known as "Steppenwolf" was formed in 1967. ER 236(¶3). The Respondent joined the "Steppenwolf" band in late 1968 and remained a

part of the band for less than a year and a half.* ER 236 (¶4), 708-710; ASER 58-62. Thus, the Ninth Circuit's apparent endorsement of the phrases, inter alia, "Original Member of" and "Original Founding Member of" preceding "Steppenwolf" as reducing the likelihood of confusion (App.A, p. 13a) overlooks the fact that the Respondent was not an original or founding member of "Steppenwolf."

On May 27, 1980, the Respondent entered into a contract with SPI and SI ("the 1980 Contract"), and agreed as follows (in ¶ 4 thereof):

> "NICK ST. NICHOLAS aka NICHOLAS KASSBAUM, ... hereby acknowledge and agree that STEPPENWOLF, INC. and STEPPENWOLF PRODUCTIONS, INC. own all right, title and interest in the name 'STEPPENWOLF'. NICK ST. NICHOLAS aka NICHOLAS KASSBAUM, ...hereby acknowledge and agree that STEPPENWOLF, INC. and STEPPENWOLF PRODUCTIONS, INC. have the sole and exclusive right to use the name 'STEPPENWOLF' in connection with the production, manufacture and distribution of phonograph records, in live, in-concert performances of a musical group, and

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*The Respondent claimed on promotional flyers that he was "Original Founding Member of Steppenwolf" (ER 145-147, 149, 539, 581), but he admitted at his deposition that he did not join the "Steppenwolf" band until after the band had released its first two albums and that he was not part of the original band (ASER 58-61).

> all other uses of the name 'STEPPENWOLF' in the entertainment industry. NICK ST. NICHOLAS aka NICHOLAS KASSBAUM, ... now and forever, waive, relinquish and release any and all of their individual or collective rights in the name 'STEPPENWOLF' or any other word or phrase incorporating the name 'STEPPENWOLF' for any purpose whatsoever...." (Emphasis added. ER 188-189, 236-238.)

In that same 1980 Contract, the Respondent also agreed (in ¶11 thereof) to be enjoined from using the name "Steppenwolf" if he breached that contract; the injunction would enjoin the Respondent:

> "...from identifying, naming or entitling any musical group...with the name 'STEPPENWOLF,' identifying, naming or otherwise entitling any musical group...with any name which includes or incorporates the name 'STEPPENWOLF,' and from using the name 'STEPPENWOLF' commercially for profit or for any other purpose whatsoever...." (Emphasis added. ER 193-194, 238-240.)

The Respondent admitted in his Complaint that he had used "Steppenwolf" to promote his performances (ER 55 (¶¶2,3), 64 (¶¶38,40)) and attached flyers showing the use by the Respondent of "Steppenwolf" in connection with the Respondent's

live performances (ER 137, 145-147, 149-151). The Respondent admitted in his response to SPI's interrogatories that the name "Steppenwolf" had been used in advertising for 33 of his live performances. ER 252-253 (¶4), 262-264. Numerous examples of such advertising are contained in the record: ER 268-281; see also ER 253(¶¶5,6), 267-328. And the Respondent stated that he intended to continue describing himself at future performances as "formerly of Steppenwolf". ER 253(¶7), 165.

But the 1980 Contract is clear: The Respondent gave up all rights to use "Steppenwolf" or any other word or phrase incorporating "Steppenwolf" for any purpose whatsoever. The District Court's Permanent Injunction was considerably narrow in that it barred the Respondent only from using use of "Steppenwolf" "to advertise or promote or market" himself. App.C, p. 16c. The injunction and the other rulings of the District Court were appropriate because:

> (a) in ¶ 4 of the 1980 Contract (ER 187 201), the Respondent acknowledged and agreed:
>
> > (i) that SPI and SI owned "all right, title and interest in the name 'STEPPENWOLF'";
> > (ii) that SPI and SI "have the sole and exclusive right to use the name 'STEPPENWOLF' in connection with....records,... performances of a musical group, and all other uses of the

name 'STEPPENWOLF' in the entertainment industry";
(iii) that he "forever waive[s], relinquish[es] and release[s] any and all of [his]...rights in the name 'STEPPENWOLF' or any other word or phrase incorporating the name 'STEPPENWOLF' for any purpose whatsoever";
(iv) that he waives, relinquishes and releases "any trademark, trade name, service mark, or service name rights...[he] may have in the name 'STEPPENWOLF'." (Emphasis added.) ER 188-189.

(b) the Respondent admitted use of the name "Steppenwolf" to advertise numerous of his performances and his intention to continue to describe himself as "formerly of Steppenwolf". E.g., ER 55, 64, 137, 145-147, 149-151.

The language of ¶ 4 of the 1980 Contract is all-encompassing: The Respondent agreed that SPI and SI exclusively owned the name 'Steppenwolf' and that he gave up any right in the name 'Steppenwolf' "for any purpose whatsoever".*

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*Moreover, the Respondent was told by his attorney, (now

The Respondent argued that when he agreed he had no right to use the name "Steppenwolf", he nevertheless kept the right to refer to his "historical" role in "Steppenwolf" even in promoting and advertising his and his band's performances. This purported right was never disclosed in the 1980 Contract or otherwise in the 18 years following the signing of the 1980 Contract (prior to the commencement of this action). ER 747-750. Paragraph 4 of the 1980 Contract contains no exception to the provisions of that paragraph reserving to the Appellant the right to use "Steppenwolf" to identify his "historical" association with the "Steppenwolf" band. Paragraph 4 admits of no exceptions: All rights to the name "Steppenwolf" belong to SPI and SI and the Respondent has no right to identify his or anyone else's performances with the word "Steppenwolf" or to use "Steppenwolf" "for any purpose whatsoever".

The Respondent repeatedly breached ¶ 4 of the 1980 Contract by using "Steppenwolf" in connection with and to promote his and his band's live performances and to promote recordings.

Now, more than 20 years after the creation of the 1980 Contract, the Respondent claims that "all" does not mean "all" but rather "all" means that although the "Steppenwolf" name belongs entirely to

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Judge) Anthony Mohr, Esq., on June 3, 1980 -- a week after the 1980 Contract was signed -- "that pursuant to this agreement [the 1980 Contract], you are giving up any right you may have had to the name 'Steppenwolf...'" (emphasis added). ER 524; ASER 57.

SPI and SI and that he may not use "Steppenwolf" for any purpose whatsoever, he can still use the name because it is an "historical" reference -- even if he is promoting his and his band's performances. But this unwritten change to the provisions of ¶ 4 is directly contrary to the all-encompassing language of ¶ 4 of the 1980 Contract and is therefore, barred by the parol evidence rule.

Thus, the District Court's grant of summary judgment in favor of SPI and SI and with respect to the Respondent's Complaint for declaratory relief and summary adjudication in SPI's favor and against the Respondent with respect to SPI's Sixth Counter-Claim for breach of the 1980 Contract were proper, as was the issuance of the Permanent Injunction enjoining the Respondent from using "Steppenwolf" again to advertise or promote or market himself. The Ninth Circuit reversed but just ignored and failed to apply the relevant Ninth Circuit and California case law in rejecting the contract claims asserted by SPI and SI.

b. Relevant state case law and Ninth Circuit precedents.

The prohibition of ¶ 4 of the 1980 Contract is clear: The Respondent was and is barred from using the name "Steppenwolf". There is no need or reason to look to the intent of the parties or to accept the Respondent's "understanding" of the terms because the prohibition is plain to see. As the Ninth Circuit held in Gates v. Rowland, 39 F.3d 1439, 1444 (9th Cir. 1994), applying California law: "The language of the contract governs if it is clear and explicit."

The Respondent's undisclosed unilateral intention to limit his obligations under the 1980 Contract is not binding on the other parties to the 1980 Contract.* Ede v. Ede, 208 Cal.App.2d 718, 721 (1962). The unexpressed thoughts of a party to a contract are irrelevant. Meyers v. Guarantee Sav. & Loan Assn., 79 Cal.App.3d 307, 311 (1978); Union Bank v. Winnebago Industries, Inc., 528 F.2d 95, 99 (9th Cir. 1975). A "party is not permitted to escape from [his] obligations by showing that he did not intend to do what his words bound him to do." Brant v. California Dairies, Inc., 4 Cal.2d 128, 134 (1935). "Testimony of intention which is contrary to a contract's express terms...does not give meaning to the contract: rather it seeks to substitute a different meaning....[S]uch evidence must be excluded." Gerdlund v. Electronic Dispensers International, 190 Cal.App.3d 263, 273 (1987).

In Blumenfeld v. R.H. Macy & Co., 92 Cal.App.3d 38 (1979), the plaintiff had assigned "all claims against third parties" to another entity but claimed that the assignment did not include a claim against Macy. The California Court of Appeal held that extrinsic evidence was "not admissible to show that Blumenfeld did not intend to assign the Macy

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* The Respondent never told John Kay that he (the Respondent) could still use "Steppenwolf" despite his agreement not to use that name. ER 747(lines 12-25), 748(lines 1-11). He never told anyone connected with SPI that he "had a historical right to use the name 'Steppenwolf' even though...[he] had agreed not to use the name...." ER 749(lines 7-17). He told no one when he had signed the 1980 Contract that he was "still going to say whenever...[he] wished that...[he was] formerly with Steppenwolf." ER 749(line 25) - 750(lines 1-5).

claim to" a third party; such evidence was irrelevant because the "all inclusive language of the agreement is not reasonably susceptible of the meaning advanced by Blumenfeld." 92 Cal.App.3d at 46. The Court of Appeal also held that:

> "Blumenfeld was simply mistaken in its belief that it had retained the Macy claim....A party is bound, even if he misunderstood the terms of a contract and actually had a different, undisclosed intention." (92 Cal.App.3d at 46.)

In Jones-Hamilton v. Beazer Materials & Services, 973 F.2d 688 (9th Cir. 1992), in which California law was applied, the Ninth Circuit wrote that:

> "The question here, then, is whether an agreement under which J-H agrees to indemnify Beazer for liability arising from J-H's violation of 'all applicable Federal, State and local laws, ordinances, codes, rules and regulations' is 'reasonably susceptible' to the meaning that it in truth refers only to all 'workman's compensation laws, overtime laws, labor laws and industrial health and safety laws.' J-H contends that, in this context, where J-H was to supply labor and facilities, and Beazer was to supply materials and expertise, this meaning is reasonable. We reject this argument: had the parties chosen to limit the

> scope of the indemnification clause in the manner J-H suggests, they would surely have made this clear in the Agreement...." (973 F.2d at 693.)

In seeking to determine the intent of the parties, "objective, not subjective, criteria..." are utilized. Brobeck, Phleger & Harrison v. Telex Corp., 602 F.2d 866, 873 (9th Cir. 1979). The Respondent may not rely on his "subjective belief to establish the meaning" of a contract. 602 F.2d at 873.

Moreover, the language of the 1980 Contract is not reasonably susceptible of the Respondent's restriction of the prohibition against his use of "Steppenwolf"; rather, that language is unambiguous. Therefore, "extrinsic evidence cannot be received for the purpose of varying the terms of the contract...." See Brobeck, supra, 602 F.2d at 871-872.

In Yount v. Acuff Rose-Opryland, 103 F.3d 830 (9th Cir. 1996), the issue was whether or not the assignment by the plaintiff of "all" of his "interest" in a song, to the predecessor of the defendant, included the right to foreign royalties. This issue is similar to the issue here: whether the Respondent's agreement not to use "Steppenwolf" "for any purpose whatsoever" included, and barred, the use by the Respondent of "Steppenwolf" not only in the name of a band, but also to identify himself in promoting and advertising his live performances. In Yount, the Ninth Circuit, in applying California law, stated that:

"Contract interpretation is governed by the objective intent of the parties as embodied in the words of the contract....And, '[t]he words of a written instrument are generally to be understood in their ordinary and popular sense.'... However, evidence of the 'subjective, uncommunicated intent of one of the parties' cannot be used to contradict the express terms of the contract....

"Yount assigned 'all' of his 'rights, title and interest' in the song to Stevenson. Those terms, if read in their 'ordinary and popular sense,' would encompass all of Yount's royalty rights from the song, including the right to foreign royalties earned during the whole term of the contract. To prevail at trial, Yount would have to demonstrate that he and Stevenson mutually intended to exclude foreign royalties despite their use of the term 'all' in the 1958 assignment; to survive a motion for summary judgment, Yount had to show that the evidence at least presented a genuine issue of material fact on that question. Yount stated that he and Stevenson never discussed foreign royalties, prior to execution of the 1958 assignment. Moreover, he did not present evidence of some industry custom or some course of dealing which would show that a transfer of all foreign royalties was excluded. That

> indicates that as far as foreign royalties are concerned 'all' meant just what it said -- his whole interest under the 4 Star agreement. Even if Yount harbored a subjective intent to exclude foreign royalties from the assignment, it is clear that he never said so. To overcome the plain meaning of the written contract, however, Yount must introduce evidence that both he and Stevenson affirmatively intended to exclude foreign royalties from the assignment -- that for them 'all' meant 'less than all.' Yount has introduced no such evidence. Thus, the district court did not err when it granted summary judgment to the McCalls on the question of foreign royalties." (103 F.3d at 835-836.)

Moreover, the parol evidence rule prohibits the Respondent's attempt to restrict the unambiguous language of the 1980 Contract. California Code of Civil Proc. § 1856(a). The parol evidence rule bars extrinsic evidence to explain the terms of a written agreement where the extrinsic evidence -- the Respondent's claims regarding his intent and understanding of the prohibition -- directly contradicts the agreement. Banco do Brasil, S.A. v. Latian, Inc., 234 Cal.App.3d 973, 1008 (1991).

In Sunniland Fruit, Inc. v. Verni, 233 Cal.App.3d 892 (1991), the plaintiff-corporation had provided $150,000 to the defendant-farmer. The plaintiff claimed that the $150,000 had been a loan

and sued to recover the $150,000. The defendant denied that the $150,000 was a loan, but if it was a loan, repayment was required only from the proceeds of the defendant's crop. The agreement provided: "The advance totaling $150,000 will be considered an interest free loan and will be deducted from the funds due the Grower." The California Court of Appeal held that the defendant's "subjective intent or understanding cannot be used to establish an intent independent from the express written terms of the agreement." 233 Cal.App.3d at 898. The California Court of Appeal reversed a judgment in favor of the defendant, holding that the trial court's interpretation of the agreement -- as not requiring repayment in the absence of net crop proceeds due the defendant -- was erroneous. 233 Cal.App.3d at 902. The California Court of Appeal also held that:

> "Under the parol evidence rule, extrinsic evidence is not admissible to contradict express terms in a written contract or to explain what the agreement was....The agreement is the writing itself....Parol evidence may be admitted to explain the meaning of a writing when the meaning urged is one to which the written contract term is reasonably susceptible or when the contract is ambiguous....Parol evidence cannot, however, be admitted to show intention independent of an unambiguous written instrument...." (Citations omitted. 233 Cal.App.3d at 898.)

Based on the foregoing analysis of applicable law, the Respondent's appeal should have been rejected because by the clear language of the 1980 Contract, he had no right to use "Steppenwolf", and his attempt to restrict the prohibition against his use of "Steppenwolf" based on his subjective and uncommunicated intent regarding, and understanding of, the 1980 Contract should have been rejected because his intent/ understanding was irrelevant.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Dated: May 4, 2001

Respectfully submitted,

/s/

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APPENDIX A

FOR PUBLICATION

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

NICHOLAS KASSBAUM, aka Nick St. Nicholas, *Plaintiff-Appellant,* v. STEPPENWOLF PRODUCTIONS, INC.; STEPPENWOLF, INC.; JOACHIM FRITZ KREUDELDAT, aka John Kay, *Defendants-Appellees.*	No. 99-55656 D.C. No. CV-97-08691-LGB OPINION

Appeal from the United States District Court
for the Central District of California
Lourdes G. Baird, District Judge, Presiding

Argued and Submitted
September 11, 2000—Pasadena, California

Filed December 29, 2000

Before: Harry Pregerson, William A. Fletcher, and Ronald M. Gould, Circuit Judges.

Opinion by Judge Gould

COUNSEL

Allen Hyman, Law Offices of Allen Hyman, North Hollywood, California, for the plaintiff-appellant.

Leonard S. Machtinger, Kenoff & Machtinger, Los Angeles, California, for the defendant-appellee.

Daniel J. Quisenberry, Kirtland & Packard, LLP, Los Angeles, California, for the amicus curiae.

OPINION

GOULD, Circuit Judge:

This case raises the issue of whether a contract between the parties or section 32(1)(a) of the Lanham Trade-Mark Act, 15 U.S.C. § 1114(1)(a) ("Lanham Act"), bars Nicholas Kassbaum ("Kassbaum"), a former member of the rock band "Steppenwolf," from referring to himself in promotional materials for a new band as "formerly of Steppenwolf," an "original member of Steppenwolf," or an "original founding member of Steppenwolf."

Kassbaum filed a complaint in federal district court seeking a declaration that he is not barred by any contract or by the Lanham Act from referring to himself as a former member of Steppenwolf. The district court (1) dismissed Kassbaum's complaint for declaratory relief; (2) granted Steppenwolf Productions, Inc. ("SPI") and Steppenwolf, Inc.'s ("SI") motion for summary judgment on both the complaint for declaratory relief and SPI's counterclaim for breach of contract;[1] (3) granted SPI and SI's request for a permanent injunction; and (4) denied Kassbaum's motion for reconsideration. Kassbaum appeals. We have jurisdiction pursuant to 28 U.S.C. § 1291 and reverse. The district court erred by (1) granting summary

[1]SPI and SI also brought counterclaims alleging unfair competition, trademark infringement and dilution of trademark, but, after the district court denied Kassbaum's motion for reconsideration of the summary judgment order, SPI and SI moved to dismiss these claims. The district court granted the motion to dismiss without prejudice.

judgment to SPI and SI; (2) dismissing Kassbaum's complaint for declaratory relief; and (3) granting SPI and SI's motion for a permanent injunction. We hold that Kassbaum is not barred by contract or by the Lanham Act from truthfully referring to himself, in promotional materials or otherwise, as a former member of Steppenwolf.

FACTS AND PROCEDURAL HISTORY

In 1967, John Kay, Jerry Edmonton, Michael Monarch and Goldie McJohn formed a musical band called "Steppenwolf." In 1968, Nicholas Kassbaum, who is professionally known as "Nick St. Nicholas," joined Steppenwolf as a bass player. That year, the band members entered into a partnership agreement whereby the members became co-equal partners and owners in Steppenwolf, and agreed to share equally the band's expenses and income. Also in 1968, the band members signed a recording agreement with Dunhill Records both as partners and as Steppenwolf band members.

From late 1968 until late April 1970, Steppenwolf, with Kassbaum as its bass player, toured the world in concerts and recorded Steppenwolf's well-received music. Kassbaum appeared prominently on Steppenwolf record album covers and authored Steppenwolf compositions. In 1971, John Kay, who had asserted control over Steppenwolf, excluded Kassbaum from the band.

In 1975, after Kassbaum and Michael Monarch had been excluded, and John Kay had stopped performing as Steppenwolf, Kassbaum and Goldie McJohn began to perform as "The New Steppenwolf." This began a series of legal disputes over the different band members' use of the name Steppenwolf.

In 1976, Kassbaum filed a complaint against SI and SPI to obtain an order prohibiting SPI from interfering with Kassbaum's performances as The New Steppenwolf. In 1977,

Kassbaum paid $17,500.00 to John Kay and SPI in exchange for their agreement to grant Goldie McJohn and Kassbaum the exclusive right to the use of the name Steppenwolf for the purposes of live performances and recordings.

In 1979, Kassbaum entered into a second agreement whereby SI and SPI granted The New Steppenwolf, Inc. the exclusive right to use the name Steppenwolf until 1981 in connection with recording, production, manufacture, sale and distribution of records and tapes containing performances of a musical group. Kassbaum performed as Steppenwolf from 1977 through 1980.

On May 27, 1980, Kassbaum, The New Steppenwolf, Inc., SI and SPI entered into a third contract ("the 1980 contract") which states, in relevant part:

> *ACKNOWLEDGEMENT [sic] AND WAIVER.* [KASSBAUM], THE NEW STEPPENWOLF, INC. and GEOFFREY EMORY hereby acknowledge and agree that [SI] and [SPI] own all right, title and interest in the name "STEPPENWOLF". [KASSBAUM], THE NEW STEPPENWOLF, INC., and GEOFFREY EMORY hereby acknowledge and agree that [SI] and [SPI] have the sole and exclusive right to use the name "STEPPENWOLF" in connection with the production, manufacture and distribution of phonograph records, in live, in-concert performances of a musical group, and all other uses of the name "STEPPENWOLF" in the entertainment industry. [KASSBAUM], THE NEW STEPPENWOLF, INC. and GEOFFREY EMORY now and forever, waive, relinquish and release any and all of their individual or collective rights in the name "STEPPENWOLF" or any other word or phrase incorporating the name "STEPPENWOLF" for any purpose whatsoever. [KASSBAUM], THE NEW STEPPENWOLF, INC. and GEOFFREY EMORY

> hereby agree to waive, relinquish and release any trademark, trade name, service mark, or service name rights any or all of them may have in the name "STEPPENWOLF." [KASSBAUM], THE NEW STEPPENWOLF, INC. and GEOFFREY EMORY further agree to transfer or assign all such trademark, trade name, service mark or service name rights they may have in the name "STEPPENWOLF" to [SI] and [SPI]. Notwithstanding anything to the contrary in the foregoing, nothing contained herein shall be deemed an acknowledgment on the part of [SI] and [SPI] that [KASSBAUM], THE NEW STEPPENWOLF, INC., and/or GEOFFREY EMORY, ever acquired or held any such trademark, trade name, service mark or service name right in the name "STEPPENWOLF."

The contract also provided that, in exchange for this acknowledgment and waiver, "[SI] and [SPI] agree to pay [KASSBAUM], THE NEW STEPPENWOLF, INC. and GEOFFREY EMORY the sum of THREE THOUSAND DOLLARS ($3,000.00)."

From 1980, when the contract was executed, until 1996, Kassbaum performed as "Lone Wolf." During that time, without objection from the parties to the 1980 contract, Kassbaum referred to his historical association with Steppenwolf, describing himself as a "former member of" or "previous member of" Steppenwolf.

From 1996 until the present, Kassbaum has performed in a group called World Classic Rockers. The group is comprised of former members of various musical groups well known to rock music fans including: Randy Meiser, a former member of "Wings;" Spencer Davis, a former member of the "Spencer Davis Group;" Bruce Gary, a former member of "Knack;" and Michael Monarch and Kassbaum, former members of Steppenwolf. While performing as the World Classic Rockers,

Kassbaum and the other band members often identified themselves by referring to their former musical associations. For example, one advertisement identifies Kassbaum as "NICK ST. NICHOLAS former member of Steppenwolf." Kassbaum also promoted himself as being a "Former Original Member of Steppenwolf," "Original Founding Member of Steppenwolf," and "Formerly of Steppenwolf."

In response to these promotional claims, SPI and SI sent Kassbaum cease and desist letters asserting that Kassbaum's historical references to Steppenwolf violated federal trademark law and the 1980 contract. Kassbaum then filed a complaint in federal district court seeking a declaration that he is entitled to refer to himself as "Formerly of Steppenwolf," an "Original Member of Steppenwolf," and an "Original Founding Member of Steppenwolf." SPI answered and filed a counterclaim alleging trademark infringement, unfair competition and breach of contract.[2] Thereafter, SPI and SI moved for summary judgment on Kassbaum's complaint for declaratory relief and SPI's counterclaim for breach of contract. SPI and SI also sought permanently to enjoin Kassbaum and his agents from using the name Steppenwolf.

The district court granted SPI and SI's motion for summary judgment on Kassbaum's complaint for declaratory relief, granted SPI's counterclaim for breach of contract, dismissed Kassbaum's complaint for declaratory relief, and granted SPI and SI's request for a permanent injunction forbidding Kassbaum from using the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf" and "Original Founding Member of Steppenwolf," in promotional materials.

Kassbaum appeals, contending that the district court erred. We agree, and we reverse and remand.[3]

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[2]Granting a motion by SPI and SI to narrow their counterclaims, the district court dismissed all counterclaims except one relating to breach of contract.

[3]Kassbaum also appeals the district court's denial of his motion for reconsideration. Because we hold that the district court erred by granting

DISCUSSION

I.

Summary Judgment and Dismissal of Declaratory Judgment Complaint

We must decide whether either the 1980 contract or the Lanham Act bars Kassbaum from referring to himself as a former member of Steppenwolf.

A. The Contract

As described above, the parties entered into the 1980 contract on May 28, 1980. We must decide whether, by the terms of the contract, Kassbaum agreed that he would not identify himself, for promotional purposes or otherwise, with a true statement that he is a former member of the band Steppenwolf.

We review decisions to grant or deny declaratory relief de novo. *Tashima v. Admin. Office of the U.S. Courts*, 967 F.2d 1264, 1273 (9th Cir. 1992). Contract interpretation is a question of law we review de novo. *Mendler v. Winterland Prod., Ltd.*, 207 F.3d 1119, 1121 (9th Cir. 2000). We also review grants of summary judgment de novo. *Robi v. Reed*, 173 F.3d 736, 739 (9th Cir. 1999). "Summary judgment is appropriate when the contract terms are clear and unambiguous, even if the parties disagree as to their meaning." *United States v. King Features Entm't, Inc.*, 843 F.2d 394, 398 (9th Cir. 1988).

[1] Under California law,[4] we interpret the 1980 contract by

summary judgment, dismissing Kassbaum's complaint and granting a permanent injunction, we need not and do not reach the reconsideration issue.

[4]The district court exercised federal question jurisdiction regarding the Lanham Act claim and supplemental jurisdiction regarding the contract

examining the contract's language, the parties' clear intentions as expressed in the contract and the circumstances under which the parties contracted. *AIU Ins. Co. v. Superior Court*, 799 P.2d 1253, 1264 (Cal. 1990) ("Under statutory rules of contract interpretation, the mutual intention of the parties at the time the contract is formed governs interpretation. Such intent is to be inferred, if possible, solely from the written provisions of the contract." (internal citation omitted)); Cal. Civ. Code § 1647 ("A contract may be explained by reference to the circumstances under which it was made, and the matter to which it relates.").

As Kassbaum concedes, there is no doubt that the 1980 contract "absolutely precludes" Kassbaum from "performing, sponsoring, or endorsing a band entitled Steppenwolf." The question is whether the contracting parties intended that broad language such as "waive, relinquish and release any and all . . . rights in the name 'STEPPENWOLF ' or any other word or phrase incorporating the name 'STEPPENWOLF ' for any purpose whatsoever" would bar Kassbaum from such things as truthfully answering a question about his past (for example) on a talk show, distributing a resume, or truthfully describing his past musical affiliations in promotional materials connected with the World Classic Rockers.

Taken out of context, the language "name 'STEPPENWOLF ' " and "for any purposes whatsoever," might be read so broadly as to preclude Kassbaum from writing "Steppenwolf " on the sidewalk in chalk. While SPI and SI do not advocate a restriction that broad, they do appear to contend that the contract language prohibits virtually any reference by Kassbaum to the name Steppenwolf in the context of the "en-

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claim. State law governs the supplemental contract claim dispute. *See, e.g., Rissetto v. Plumbers and Steamfitters Local 343*, 94 F.3d 597, 601 (9th Cir. 1996). Here, the parties are from California, the 1980 contract was formed in California, and we apply California law to the contract claim.

tertainment industry." Thus, SPI and SI contend that Kassbaum contracted away his ability to refer to his past association with Steppenwolf in a resume sent to a recording company, or in a music industry interview touching upon his background, or, at the center of this case, in his promotional references relating to his performance with World Classic Rockers.

[2] We must read the words of the 1980 contract in context. Cal. Civ. Code § 1641. ("The whole of a contract is to be taken together, so as to give effect to every part, if reasonably practicable, each clause helping to interpret the other."); *Id.* § 1650 ("Particular clauses of a contract are subordinate to its general intent."). We may not read the contract in a manner that leads to an absurd result. *Id.* § 1638 (courts must look at contract language to discern parties' intent so long as the result "does not involve an absurdity"); *Id.* § 1639. Rather, when we encounter broad language such as "for any purposes whatsoever," we must extend the meaning of such language to cover only those things which it appears the parties intended to contract. *Id.* § 1648 ("However broad may be the terms of a contract, it extends only to those things concerning which it appears that the parties intended to contract."). When broad language is at issue, we must look to the circumstances under which the parties contracted to determine their intentions at the time of contracting. *Id.* § 1647.

[3] Here, those circumstances are a continuing dispute between the parties about ownership and control over the trade name Steppenwolf. Over the years, such ownership and control was transferred from party to party through a series of contracts. First, all of the original band members owned the trade name Steppenwolf. Then, in 1977, after Kassbaum was asked to leave Steppenwolf and began to perform as The New Steppenwolf, the parties resolved a dispute over the right to the trade name Steppenwolf by having Kassbaum pay $17,500.00 to SPI in exchange for the exclusive right to perform as Steppenwolf for the purpose of live performances and

recordings. The parties entered into a second agreement in 1979, whereby SI and SPI granted Kassbaum and The New Steppenwolf, Inc. the exclusive right to use the name Steppenwolf in connection with recording, production, manufacture, sale and distribution of records and tapes embodying performance of a musical group until 1981. At the time the parties entered into the 1980 contract, Kassbaum owned the trade name Steppenwolf to the extent specified by the 1979 contract, and had been performing as The New Steppenwolf. The 1980 contract effected the transfer of the trade name Steppenwolf from Kassbaum and The New Steppenwolf to SPI and SI. Thereafter, Kassbaum discontinued his performances as The New Steppenwolf, and began to perform as Lone Wolf and later as a part of the World Classic Rockers.

[4] Under these circumstances, it is clear that the contract's broad language "for any purposes whatsoever," and "all other uses of the name 'STEPPENWOLF' in the entertainment industry" refers to use of the *trade name* Steppenwolf, and not to the simple use of the name to provide accurate historical information that would not lead reasonable people to think Kassbaum's new band was Steppenwolf. The terms of the contract do not bar Kassbaum from referring to his former membership in Steppenwolf in the entertainment industry or otherwise. We therefore hold that the district court erred by granting summary judgment to SPI and SI on the contract counterclaim and by dismissing Kassbaum's complaint for declaratory relief on contract grounds.

B. The Lanham Act

Kassbaum's complaint requests, inter alia, a declaratory judgment that section 32(1)(a) of the Lanham Act, 15 U.S.C § 1114(1)(a), does not bar him from stating, particularly in promotional materials, that he was "Formerly of Steppenwolf," an "Original Member of Steppenwolf," or an "Original Founding Member of Steppenwolf." The district court dis-

missed Kassbaum's complaint and granted SPI and SI's motion for summary judgment. We reverse.

[5] The Lanham Act provides, in pertinent part:

> (1) Any person who shall, without the consent of the registrant —
>
> (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .
>
> shall be liable in a civil action by the registrant . . . .

15 U.S.C. § 1114(1).

[6] The purpose of a trademark is to allow customers to identify the manufacturer or sponsor of a good or the provider of a service. *New Kids on the Block v. News. Am. Pub., Inc.*, 971 F.2d 302, 305 (9th Cir. 1992). Actual consumer confusion is not required for profit recovery; it is sufficient to show a likelihood of confusion combined with willful infringement. *Gracie v. Gracie*, 217 F.3d 1060, 1068 (9th Cir. 2000). For the reasons that follow, we believe that Kassbaum's references to himself in promotional materials as "Formerly of Steppenwolf," an "Original Member of Steppenwolf," and an "Original Founding Member of Steppenwolf," do not cause a likelihood of confusion.[5]

[5]We consider the following factors to test for likelihood of confusion under the Lanham Act: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

[7] First, we believe the phrases "Formerly of," "Original Member of" and "Original Founding Member of," immediately preceding the name "Steppenwolf" in the promotional materials for World Classic Rockers greatly reduce the likelihood of confusion about the source of the band's music.

[8] Additionally, the context of the historical references to Kassbaum's affiliation with Steppenwolf in World Classic Rockers' promotional materials further reduces any likelihood of confusion between these two bands. In all promotional materials presented to the district court, references to World Classic Rockers are more prominent than are references to Steppenwolf. The materials display the title "World Classic Rockers" on the top or at the center of the page, while references to the band members' former groups, including Steppenwolf, are displayed on the bottom or around the edges of the page. Also, the title "World Classic Rockers" appears in large and bold lettering, while smaller and plainer lettering is used for the titles of the former groups, including Steppenwolf. Finally, while the materials mention multiple former groups, the materials promote only World Classic Rockers, not Steppenwolf, or any other former band.[6]

Our holding is supported by cases in similar contexts. For example, in *Kingsmen v. K-Tel International Ltd.*, 557 F. Supp. 178 (S.D.N.Y 1983), the district court distinguished the likelihood of confusion that exists when a former member of a band re-records a song under the name of the original band from the likelihood of confusion that exists when the former member re-records a song under his own name with the designation "formerly of" the original band displayed on the recording. The first situation, the court stated, created a likelihood of confusion under the Lanham Act, while the latter,

[6]While it is possible that a billboard with "Steppenwolf" printed in eight-foot lettering and "formerly of" printed in two-inch lettering might cause a likelihood of confusion sufficient to support a claim under the Lanham Act, that situation is not before us, and we do not consider it.

although not then before the court, would not. *Id.* at 183-184 ("[W]e would see no objection to defendants' marketing of this particular recording of Louie, Louie under the name of Jack Ely with the caption, 'formerly of the Kingsmen' or 'Jack Ely, lead singer on the original Kingsmen recording of Louie, Louie.' It is the representation that the rendition of Louie, Louie appearing on defendants' album was re recorded by the individuals collectively known as The Kingsmen that we find likely to confuse and therefore objectionable under the Lanham Act.").

In *Playboy Enterprises, Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998), the district court addressed concerns regarding the differences between commercial trademark use and descriptions of individuals that use trade names. In that case, the publisher of Playboy sued a former "Playmate of the Year" for so designating herself on her personal web site, asserting various claims related to trademark. In denying the publisher's motion for preliminary injunction, the court held that defendant was entitled to the "fair use" defense. *Id.* at 1103. ("The 'fair use' defense, in essence, forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods." (Internal quotations omitted)). In holding that the "fair use" defense applied, the court noted that "[i]n the case at bar, Ms. Welles has used the trademark term Playmate of the Year to identify and describe herself .... Ms. Welles earned the title of 'Playboy Playmate of the Year' in 1981 and has used that title ever since, without objection." *Id.* Because the court applied the "fair use" defense, it found it unnecessary to determine the likelihood of confusion under the Lanham Act. *Id.* at 1104. The court, however, went on to state that it did not see any likelihood of confusion under this circuit's eight-factor test. *Id.* at 1104-05.

Finally, we wholeheartedly agree with Justice Holmes's statement about the limits of trademark protection in *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924): "When the

mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo." We reverse the district court's order granting summary judgment to SPI and SI and dismissing Kassbaum's complaint for declaratory judgment as to the Lanham Act issue.

II.

Permanent Injunction

The district court granted SPI and SI's request for a permanent injunction precluding Kassbaum and his agents from using the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf," and "Original Founding Member of Steppenwolf " in promotional materials. Because we hold that Kassbaum is not barred by contract or by the Lanham Act from using these designations, we reverse.

III.

Declaratory Judgment in Favor of Kassbaum

Our analysis of issues raised in the context of the district court's summary judgment and dismissal order invites the question whether we will, on appeal, grant Kassbaum the declaratory relief that he sought in the district court notwithstanding that Kassbaum did not move for summary judgment on his complaint. We will not.

It is generally recognized that a court has the power sua sponte to grant summary judgment to a non-movant when there has been a motion but no cross-motion. *Cool Fuel, Inc. v. Connett*, 685 F.2d 309, 311 (9th Cir. 1982) (When one party moves for summary judgment and at a hearing the record reveals no genuine dispute on a material fact, "the overwhelming weight of authority supports the conclusion that . . . the court may sua sponte grant summary judgment to

the non-moving party."); *Golden State Transit Corp. v. City of Los Angeles*, 563 F. Supp. 169, 170-71 (C.D. Cal. 1983) (When the parties agreed that there were no issues of material fact, the court noted that "[i]n the absence of any factual issues, the Court may grant summary judgment to either party without requiring that a cross-motion be filed."); 10A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, Federal Practice and Procedure § 2720 at 347 (3d ed. 1998).

However, the propriety of granting summary judgment in favor of a party who did not so move is often a "close question." *Sohappy v. Hodel*, 911 F.2d 1312, 1320 (9th Cir. 1990) (noting that "[a] close question is presented whether summary judgement should be entered in favor of the plaintiffs although they filed no such motion" and remanding to afford the defendant an opportunity to present evidence on this issue under consideration). Moreover, if a court concludes that a non-moving party is entitled to judgment, "great care must be exercised to assure that the original movant has had an adequate opportunity to show that there is a genuine issue and that his [or her] opponent is not entitled to judgment as a matter of law." *Ramsey v. Coughlin*, 94 F.3d 71, 74 (2d Cir. 1996) (quoting 10A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, Federal Practice and Procedure § 2720 at 34 (2d ed. 1983)).

Further, we should not reverse a summary judgment and order judgment for a non-moving party based on an issue that the movant had no opportunity to dispute in the district court. *Fountain v. Filson*, 336 U.S. 681, 683 (1949), is instructive. There, based on one issue raised in the plaintiff 's claim, the defendants moved for, and the district court granted, summary judgment against the plaintiff. *Id.* at 682. The court of appeals reversed, and, although the plaintiff never cross-motioned for summary judgment, remanded with instructions for the district court to grant summary judgment in favor of the plaintiff based on a second issue raised in the plaintiff 's claim. *Id.* The United States Supreme Court reversed, holding that the court

of appeals had deprived the defendant of the opportunity to dispute any of the facts relating to the second issue in the plaintiff 's claim because the district court had only considered the first issue. *Id.* at 683.

Here, Kassbaum brought a complaint seeking declaratory judgment regarding the 1980 contract and the Lanham Act. When the district court granted summary judgment to SPI and SI on the complaint as a whole, the district court's discussion was limited to the contract issue. While these circumstances do not preclude us from granting summary judgment to Kassbaum, and while we view the issues presented in the declaratory judgment complaint in Kassbaum's favor and are inclined to view the evidence before us as complete, in the exercise of caution we decline to grant sua sponte summary judgment of declaratory relief to Kassbaum on the record before us. The district court may consider this declaratory judgment issue after the parties have notice of our decision and an opportunity to be heard.

CONCLUSION

We reverse the district court's order (1) granting summary judgment to SPI and SI on the complaint for declaratory judgment and on the contract counterclaim; (2) dismissing Kassbaum's complaint for declaratory judgment; and (3) granting SPI and SI's request for a permanent injunction. We remand to the district court with instructions to reinstate Kassbaum's complaint for declaratory relief and for further proceedings consistent with this opinion.

REVERSED and **REMANDED**.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

NICHOLAS KASSBAUM, aka Nick St. Nicholas,	) FILED
	) FEB –7, 2001
	) CATHY A. CATTERSON,
Plaintiff/Appellant,	) CLERK
	) U.S. COURT OF
v.	) APPEALS
	) No. 99-55656
STEPPENWOLF PRODUCTIONS, INC.; STEPPENWOLF, INC.; JOACHIM FRITZ KREUDELDAT, aka John Kay,	)
	) D.C. No.
	) CV-97-98991-LGB
	) ORDER
	)
	)
	)
Defendants-Appellees.	)
	)

Before: PREGERSON, W. FLETCHER, and GOULD, Circuit Judges.

The panel as constituted above has voted to deny the petition for rehearing and the petition for rehearing en banc.

The full court has been advised of the petition for rehearing en banc and no judge of the court has requested a vote on it. Fed.R.App.P.35(b).

The petition for rehearing and the petition for rehearing en banc are DENIED.

APPENDIX C

UNTED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

NICHOLAS KASSBAUM, aka Nick St. Nicholas, an individual,	FILED CLERK, U.S. DISTRICT COURT JAN -6 1999
Plaintiff,	CENTRAL DISTRICT OF CALIFORNIA
v.	DEPUTY
STEPPENWOLF PRODUCTIONS, INC., a California corporation; STEPPENWOLF, INC., a California corporation; JOACHIM FRITZ KREUDELDAT, aka JOHN KAY, an individual,	ENTERED CLERK, U.S. DISTRICT COURT JAN -8 1998 [sic] CENTRAL DISTRICT OF CALIFORNIA BY DEPUTY
	CV-97-8691 LGB (CWx)
Defendants.	ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT
STEPPENWOLF PRODUCTIONS, INC.	
Counter-claimant,	

v.)
)
NICHOLAS KASSBAUM,)
aka NICK ST. NICHOLAS,)
and DOES 1-20, inclusive.)
)
Counter-defendants.)

I. INTRODUCTION

Plaintiff Nicholas Kassbaum, aka Nick St. Nicholas, ("Plaintiff") was a former member of the rock band "Steppenwolf." After using various designations ("formerly of Steppenwolf," "original member of Steppenwolf," and "original founding member of Steppenwolf") to refer to himself, Defendants Steppenwolf, Inc. ("SI") and Steppenwolf Productions, Inc. ("SPI") (collectively "Defendants") sent him cease and desist letters indicating that he was violating federal trademark law as well as certain agreements that he had previously entered into. Plaintiff then filed this declaratory relief action, seeking a declaration that he is entitled to utilize the above designations. SPI answered the Complaint and filed a Counter-Claim against Plaintiff, alleging claims for trademark infringement and breach of contract.

By the instant motion, SPI and SI move for summary judgment with respect to Plaintiff's complaint for declaratory relief and SPI's counter-claim for breach of contract. Defendants also seek a permanent injunction enjoining Kassbaum and his agents from using the name "Steppenwolf."

For the reasons set forth below, this Court GRANTS Defendants' motion for summary judgment on Plaintiff's complaint for declaratory relief and SPI's counter-claim for breach of contract.

II. FACTUAL BACKGROUND

The following facts are undisputed, unless otherwise noted.

Plaintiff Kassbaum, was a member of the rock bank "Steppenwolf" from late 1968 to late April 1970. See Compl. ¶ 17; Kay Decl., ¶ 4. On May 27, 1980, Plaintiff entered into a contract (the "1980 Contract") with Defendants SI and SPI wherein Plaintiff agreed that "SPI and SI own all right, title and interest in the names 'Steppenwolf'" and that SPI and SI "have the sole and exclusive right to use the name 'Steppenwolf' in connection with . . . records, . . . performances of a musical group, and all other uses of the name 'Steppenwolf' in the entertainment industry." Plaintiff further agreed to relinquish all rights in the name "'Steppenwolf' or any other word or phrase incorporat[ing] the name 'Steppenwolf' for any purpose whatsoever." See Kay Decl., ¶ 5, Exh. A, ¶ 4. In the 1980 Contract, Kassbaum also agreed to be enjoined from using the name "Steppenwolf" if he breached that contract. See Kay Decl., ¶ 5, Ex. A, ¶ 11. In exchange, SPI and SI agreed to pay Kassbaum and Geoffrey Emory the sum of $3,000.00 payable in increments of $100.00 a month for thirty months commencing on June 1, 1980. See Kay Decl., Ex. A, ¶ 3. The disbursements were to be sent directly to Anthony Mohr, Kassbaum's attorney, for deposit as a fee advance. See Kassbaum Decl., ¶¶ 41, 42, 51.

The 1980 Contract was executed on behalf of the two corporations by their president, Defendant John Kay ("Kay"). See Compl. ¶ 33, Ex. 10.

Thereafter, Plaintiff toured and performed with a musical group called "Lone Wolf." See id. ¶ 34. Plaintiff also formed a musical group know as the "World Classic Rockers" which included former members of such rock groups as "Toto," "Wings," and the "Eagles." See id. ¶ 36. In promoting the "World Classic Rockers," Plaintiff advertised himself as being a "Former Original Member of Steppenwolf," "Original Founding Member of Steppenwolf" and "Formerly of Steppenwolf." See id. ¶¶ 38, 39 and 40; Machtinger Decl., ¶ 4, Ex. C, ¶¶ 5, 6. In response, SPI sent four letters to Plaintiff demanding that he cease and desist from referring to both his current position as a member of "Lone Wolf" and his former association with Steppenwolf because such references purportedly infringed its trademark rights in the "Steppenwolf" name. See Compl. ¶¶ 42, 43, 44.

III. PROCEDURAL BACKGROUND

On November 25, 1997, Plaintiff filed a Complaint with this Court seeking a declaratory judgment against SI, SPI, and Kay claiming that he is entitled to state his former association with the group "Steppenwolf" by stating in promotional materials that he was "Formerly of Steppenwolf," that he was an "Original Member of Steppenwolf," and that he was an "Original Founding Member of Steppenwolf," See id. at ¶ 46. Federal question jurisdiction is predicated on the Lanham Act, 15 U.S.C. §1114. See id. ¶¶ 1,3.

On January 6, 1998, SPI answered the Complaint and filed a Counter-Claim against Plaintiff alleging the following claims for relief: (1) federal unfair competition, 15 U.S.C. §1125(a); (2) federal trademark infringement, 15 U.S.C. §1114; (3) federal trademark dilution, 15 U.S.C. §1125(c); (4) common law trademark and trade name infringement; (5) common law unfair competition; and (6) breach of contract. SI subsequently answered the Complaint on February 27, 1998.

By Order dated April 3, 1998, this Court granted Defendant's Motion to Dismiss John Kay as a defendant in this action pursuant to Federal Rule of Civil Procedure 12(b)(6).

On November 25, 1998, SPI and SI filed the instant motion for summary judgment with respect to Plaintiff's complaint for declaratory relief and SPI's sixth counter-claim for breach of the 1980 Contract. Plaintiff filed an opposition to Defendants' motion on December 9, 1998, and Defendants filed a reply thereto on December 14, 1998. On December 23, 1998, Plaintiff filed a surreply in opposition to Defendants' reply memorandum. A hearing for this motion was held on January 4, 1999, at which time the Court took the matter under submission.

IV. STANDARD FOR SUMMARY JUDGMENT

A court must enter summary judgment against a party who, after adequate time for discovery and upon motion, fails to make a showing sufficient to establish an element essential to that party's case, and on which that party would bear the

burden on proof at trial. See Fed. R. Civ. P. 56(c); Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). A party moving for summary judgment may carry its initial burden by pointing out to the district court that there is an absence of a genuine issue of material fact. See id. at 323.

To avoid summary judgment, the non-movant must set forth specific facts showing that there remains a genuine issue of material fact for trial. See id. at 324. The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in the non-movant's favor. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). If the non-moving party's evidence is merely colorable or is not significantly probative, a court may grant summary judgment. See id. Moreover, "neither the existence of some alleged factual dispute between the parties," see Anderson, 477 U.S. 242, 247 (1986), nor the demonstration of "some metaphysical doubt as to the material facts," see Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986), will sufficiently demonstrate a genuine issue of fact. In that regard, the "mere existence of a scintilla of evidence in support of the plaintiff's position will be insufficient." See Anderson, 477 U.S. at 252.

V. ANALYSIS

Defendants SPI and SI have moved for summary judgment against Plaintiff Kassbaum with respect to Plaintiff's complaint for declaratory relief that he has a right to use the following designations in promotional materials: "Formerly of Steppenwolf," "Original Member of Steppenwolf," and "Original

Founding Member of Steppenwolf." Defendants have also moved for summary judgment on SPI's counter-claim for breach of the 1980 Contract. In addition, Defendants move for a permanent injunction enjoining Kassbaum and his agents from using the name "Steppenwolf" in accordance with Paragraph 11 of the 1980 Contract. In opposition to SPI and SI's motion for summary judgment, Plaintiff contests both the validity and meaning of 1980 Contract.[1]

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[1]Pursuant to Federal Rule of Civil Procedure 56(f), Plaintiff also seeks to delay the disposition of the instant motion for summary judgment until he can take the deposition of SPI. See Cloverdale Decl., ¶ 18-24.

Rule 56(f) provides: "Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such order as is just." Fed. R. Civ. P. 56(f). In making a Rule 56(f) motion, an opposing party must make clear what facts or information is sought and how it would raise a material issue of fact to preclude summary judgment." See Margolis v. Ryan, 140 F.3d 850, 853 (9th Cir. 1998); see also Terrell v. Brewer, 140 F. 2d 1015, 1018 (9th Cir. 1991); Taylor v. Sentry Live Ins. Co., 729 F.2d 652, 656 (9th Cir. 1984).

Here, in support of his request for a Rule 56(f) continuance, Plaintiff asserts only that "it is imperative that Plaintiff be allowed to request responses from the defendant as to defendants' understanding of the contract and its terms, under oath." See Cloverdale Decl., ¶ 23. This is insufficient to justify a Rule 56(f) continuance. The Cloverdale Declaration fails to set forth what facts or information is sought and how it would enable Plaintiff to raise a genuine issue of material fact.

Moreover, the discovery cut-off for this matter was October 30, 1998. According to the Cloverdale Declaration, the SPI deposition was scheduled for September 28, 1998; thus, the dispute among counsel as to the location of said deposition arose

First, Plaintiff contends that the motion should be denied because Defendants failed to perform under the 1980 Contract by tendering the promised payment of $3,000.00. Plaintiff also asserts that there exists genuine issues of fact as to the proper interpretation of the 1980 Contract. The Court addresses these contentions in turn.

1. Performance under the 1980 Contract

Plaintiff contends that there is no competent evidence that Defendants ever paid the promised $3,000.00 in consideration for Kassbaum's waiver and release of all his rights in the "Steppenwolf" name. See Pl.'s Opp. at 3:9-4:8; Kassbaum Decl., ¶¶ 47, 62.[2] However, at his deposition, after first

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before the date of the scheduled deposition. Nonetheless, Plaintiff's first attempt to compel the deposition of SPI was on December 4, 1998, more than two months after the dispute arose and after both the discovery cut-off date and ten days before the motions cut-off date. For the foregoing reasons, Plaintiff's request for Rule 56(f) continuance is DENIED.

[2]Plaintiff submitted several objections to the Supplemental Declarations of John Kay, dated December 11, 1998, filed and served in support of Defendants' Motion for Summary Judgment. The Court sustains Plaintiff's objections on the grounds of hearsay and lack of foundation with regard to the following:

1) Kay Supp. Decl., ¶ 3, p. 2:19-3:5; ¶ 3(a), p. 7-10; ¶ 3(c), p. 3:27-4:5; ¶ 3(d), p. 4:9-13.

2) Exhibit H

contending that the $3,000.00 had not been paid, see Machtinger Supp. Decl., Ex. L, Kassbaum Depo., at 128:17-23; 129:1-3, Plaintiff stated that the promised payments from SPI were in fact received by Anthony Mohr, Kassbaum's attorney. See Kassbaum Depo., at 134:24-25; 135:1-13. Plaintiff also testified that he received $1,500.00 of the promised $3,000.00 from Mohr, and that Mohr had advised him that the other $1,500.00 had been "applied toward legal fees." See Kassbaum Depo., at 135:14-19; 136:3-7. Thus, Plaintiff's own admissions defeat his instant attempt to convince this Court that there exists a genuine issue for trial as to any material fact with regard to whether Defendants ever paid the $3,000.00 in consideration for the 1980 Contract.

2. Interpretation of the 1980 Contract

Interpretation of the 1980 Contract is a matter of law for the Court to decide. See U.S. v. King Features Ent. Inc., 843 F.2d 394, 397 (9th Cir. 1988); see also Beck Park Apts. v. U.S. Dept. of Housing, 695 F.2d 366, 369 (9th Cir. 1982). Whether a contract is ambiguous is also a question of law. See Beck, 69 F.2d 369. Summary judgment is appropriate when the contract terms are clear and unambiguous, even if the parties disagree as to their meaning. See King Features, 843 F.2d at 397; see also Int'l. Union of Brick Layers v. Martin Jaska Inc., 752 F.2d 1401, 1406 (9th Cir. 1985).

Under California law, even if the written agreement of the parties is clear and unambiguous

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The Court overrules Plaintiff's objections with regard to the following:

1) Kay Suppl. Decl., ¶ 3(b), p.3:13-15; ¶ 3(b), p. 3-24-25.

on its face, a court must consider relevant extrinsic evidence that can prove a meaning to which the language of the contract is reasonably susceptible. See King Features, 843 F.2d at 397; see also Brobeck, Phleger & Harrison v. Telex Corp., 602 F.2d 866, 871 (9th Cir. 1979), cert. denied, 444 U.S. 981, 100 S.Ct. 483, 62 L.Ed.2d 407 (1979); Union Bank v. Winnebago Indus., Inc., 528 F.2d 95, 98 (9th Cir. 1975). However, if after considering extrinsic evidence the court finds the language of the contract is not reasonably susceptible to the asserted interpretation and is unambiguous, extrinsic evidence cannot be received for the purpose of varying the terms of the contract. See Brobeck, 602 F.2d at 871. The case may then be disposed of by summary judgment because interpretation of the unambiguous contract is solely a question of law. See id. (citations omitted).

Here, the terms of the 1980 Contract are clear and unambiguous. Kassbaum, a signatory to the 1980 Contract, agreed that "SPI and SI own all right, title and interest in the names 'Steppenwolf'" and that SPI and SI "have the sole and exclusive right to use the name 'Steppenwolf' in connection with . . . records, . . . performances of a musical group, and all other uses of the name 'Steppenwolf' in the entertainment industry." Plaintiff further agreed to relinquish all rights in the name "'Steppenwolf' or any other word or phrase incorporat[ing] the name 'Steppenwolf' for any purpose whatsoever." See Kay Decl., ¶ 5, Ex. A, ¶ 4 (emphasis added). In the 1980 Contract, Kassbaum also agreed to be enjoined from using the name "Steppenwolf" if he breached that contract. See Kay Decl., ¶ 5, Exh. A, ¶ 11.

The 1980 Contract is thus unambiguous on its face. As noted, however, California law allows a party to challenge a contract that is unambiguous on its face, see Brobeck, 602 F.2d at 873, and accordingly, Kassbaum presents extrinsic evidence to this Court in order to show that the contract was susceptible of a different meaning.

The extrinsic evidence advanced by Kassbaum consists almost exclusively of Kassbaum's own understanding and intention that the 1980 Contract prohibited him only from recording records as "Steppenwolf" or using "Steppenwolf" in the name of a band. See Pl.'s Opp. at 4:14-21. However, Kassbaum's subjective belief is irrelevant in determining the meaning of the 1980 Contract. See Brobeck, 602 F.2d at 873. Under the modern theory of contracts, courts look to objective, not subjective, criteria in asserting the intent of the parties. See id; see also Meyer v. Benko, 55 Cal. App. 3d 937 (1976). Moreover, the undisclosed independent intention of Plaintiff is neither relevant nor binding on the other parties to the 1980 Contract. See Ede v. Ede, 208 Cal.App.2d 718, 721 (1962). Plaintiff offers no evidence that he ever communicated an intention to limit his obligations under the 1980 Contract. The unexpressed thoughts of a party to a contract are simply irrelevant. See Meyers v. Guaranteed Sav. & Loan Assn., 79 Cal.App.3d 307, 311 (1978). "Testimony of intention which is contrary to a contract's express terms. . . does not give meaning to the contract; rather it seeks to substitute a different meaning. . . such evidence must be excluded." See Gerdlund v. Electronic Dispensers Int'l., 190 Cal. App. 3d 263, 273 (1987).

Plaintiff also submits that the fact that Defendants themselves refer to Plaintiff's past membership, history and performance with the band Steppenwolf, indicates the parties' intention to allow Plaintiff to refer to this past affiliation with Steppenwolf. However, again, the clear language of the 1980 Contract is the best evidence of SPI's intent. The 1980 Contract clearly provides that SPI and SI "have the sole and exclusive right to use the name 'Steppenwolf' in connection with...records,... performances of a musical group, and all other uses of the name 'Steppenwolf' in the entertainment industry." See Kay Decl., ¶ 5, Ex. A, ¶ 4 (emphasis added). The right to refer to the name "Steppenwolf" is explicitly reserved to SPI and SI. The use of the words "sole" and "exclusive" evidences a clear and unambiguous intention by the parties to the 1980 Contract to limit that right to SPI and SI's use.

Thus, the Court finds that the extrinsic evidence offered by Plaintiff does not make the contract reasonably susceptible to a different interpretation. The terms of the 1980 Contract remain unambiguous, and thus disposition of the case by summary judgment is appropriate. See Brobeck, 602 F.2d at 874; see also Airborne Freight Corp. v. McPherson, 427 F.2d 1283, 1286 (9th Cir. 1970). In light of the express terms of the 1980 Contract, Plaintiff's continued use of the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf," and "Original Founding Member of Steppenwolf" to promote his band, "World Class Rockers," is in violation of the terms of the

1980 Contract.[3] As such, Defendants are entitled to enjoin Plaintiff from using said designations in his promotional material. See Kay Decl., ¶ 5, Exh. A, ¶ 11.

VI. CONCLUSION

For the foregoing reasons, this Court GRANTS Defendants' motion for summary judgment on Plaintiff's complaint for declaratory relief and SPI's counter-claim for breach of contract. This Court also GRANTS Defendants' request for a permanent injunction, precluding Kassbaum and his agents from using the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf," and "Original Founding Member of Steppenwolf," in promotional materials. Defendant is ORDERED to file a proposed injunction in conformance with this Order and Paragraph 11 of the 1980 Contract within ten days of this Order. Defendant may file objections within ten days of the filing of the proposed order. A

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[3]During the hearing for this matter, Plaintiff argued that construing the 1980 Contract to preclude Plaintiff from any use of the name "Steppenwolf," including for example, references to Plaintiff's past affiliation with "Steppenwolf" in a biography or resume, would be an unduly broad interpretation. However, the issue of whether these potential uses of the name "Steppenwolf" would be in violation of the terms of the 1980 Contract is not before this Court. The only issues before this Court, and thus the only issues this Court decides, are those raised in Plaintiff's complaint for declaratory relief and Defendant's counter-claim for breach of contract; that is, whether Plaintiff's use of the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf," and "Original Founding Member of Steppenwolf" to promote his band, "World Class Rockers," is in violation of the terms of the 1980 Contract. This Court has found that such promotional uses are in violation of
the terms of the 1980 Contract.

telephone status conference is set for February 4, 1999 at 5:00 p.m.

IT IS SO ORDERED.
DATED: January 5, 1999

/s/ Lourdes G. Baird
Lourdes G. Baird

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

NICHOLAS KASSBAUM, aka NICK ST. NICHOLAS, an individual, Plaintiff, v. STEPPENWOLF PRODUCTIONS, INC., a California corporation; STEPPENWOLF, INC.; a California corporation JOACHIM FRITZ KREUDELDAT, aka JOHN KAY, an individual, Defendants.	) FILED) CLERK, U.S. DISTRICT) COURT) MAR 16, 1999) CENTRAL DISTRICT OF) CALIFORNIA) BY DEPUTY)) ENTERED) CLERK, U.S. DISTRICT) COURT) MAR 18, 1999) CENTRAL DISTRICT OF) CALIFORNIA) BY DEPUTY)) No.) CV-97-8691 LGB (CWx)
STEPPENWOLF PRODUCTIONS, INC. Counter-claimant, v. NICHOLAS KASSBAUM, aka NICK ST. NICHOLAS, and DOES 1-20, inclusive. Counter-defendants.	) PERMANENT) INJUNCTION

Pursuant to this Court's Order, entered on January 8, 1999, it is ORDERED, ADJUDGED AND DECREED that Nicholas Kassbaum, also known as Nick St. Nicholas is permanently restrained, enjoined and prohibited from:

(1) using or causing, directly or indirectly, orally or in writing, the designations "Formerly of Steppenwolf," "Original Member of Steppenwolf" and "Original Founding Member of Steppenwolf" and all other designations that include the word "Steppenwolf" to advertise or promote or market Nicholas Kassbaum aka Nick St. Nicholas; and (2) manufacturing, selling and/or distributing the recordings entitled "World Class Rockers" and "Easy Ridin" while the word "Steppenwolf" appears in reference to Nicholas Kassbaum aka Nick St. Nicholas on any liner notes, inserts, recording covers or elsewhere with respect to the aforesaid recordings.

This injunction shall not restrain the following conduct:

(a) References to "Steppenwolf" in an autobiography, biography or memoir of Kassbaum; and

(b) References to "Steppenwolf" in liner notes, inserts or covers of records that were manufactured on or before the date of this injunction.

The Court shall retain jurisdiction of this case for such other and further orders as may be necessary to enforce this injunction.

IT IS SO ORDERED.
DATED: March 16, 1999

/s/ Lourdes G. Baird
LOURDES G. BAIRD
United States District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

NICHOLAS KASSBAUM, aka NICK ST. NICHOLAS, an individual, Plaintiff, v. STEPPENWOLF PRODUCTIONS, INC., a California corporation; STEPPENWOLF, INC.; a California corporation JOACHIM FRITZ KREUDELDAT, aka JOHN KAY, an individual, Defendants.	FILED CLERK, U.S. DISTRICT COURT MAY 19, 1999 CENTRAL DISTRICT OF CALIFORNIA BY DEPUTY ENTERED CLERK, U.S. DISTRICT COURT MAY 20, 1999 CENTRAL DISTRICT OF CALIFORNIA BY DEPUTY Case No. 97-8691 LGB (MSNx) FINAL JUDGMENT
STEPPENWOLF PRODUCTIONS, INC., Counter-claimant, v. NICHOLAS KASSBAUM, aka NICK ST. NICHOLAS; and DOES 1-20, inclusive. Counter-defendants.	

Pursuant to this Court's Order of January 8, 1999, granting the motion for summary judgment, with respect to the Complaint for Declaratory Relief of plaintiff Nicholas Kassbaum, in favor of defendants Steppenwolf Productions, Inc. and Steppenwolf, Inc. and against plaintiff Kassbaum, and granting the motion for summary judgment with respect to the Sixth Counter-Claim of Steppenwolf Productions, Inc. for breach of contract in favor of counter-claimant Steppenwolf Productions, Inc. and against counter-defendant Kassbaum,

IT IS HEREBY ORDERED AND ADJUDGED that:

1. Plaintiff and counter-defendant Nicholas take nothing under his Complaint for Declaratory Relief;

2. Kassbaum's Complaint for Declaratory Relief is hereby dismissed on the merits;

3. Kassbaum is liable with respect to the Sixth Counter-Claim of Steppenwolf Productions, Inc.; and

4. Their permanent injunction entered March 18, 1999, against plaintiff and counter-defendant Kassbaum shall remain in full force and effect.

5. This Court shall retain jurisdiction of this case for such other and further orders as may be necessary to enforce the aforesaid injunction.

6. Defendant and counter-claimant Steppenwolf Productions, Inc. and defendant Steppenwolf, Inc. shall recover their costs in the amount of $_____.

Dated: May 19, 1999

/s/ Lourdes G. Baird
United States District Judge

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